



[3510-16-P]

DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

[Docket No.: PTO-P-2015-0064]

Use of WIPO's ePCT System for Preparing the PCT Request for Filing as Part of an International Application with the USPTO as Receiving Office

AGENCY: United States Patent and Trademark Office, Commerce

ACTION: Notice.

SUMMARY: The United States Patent and Trademark Office (Office or USPTO), in its capacity as a PCT Receiving Office (RO/US), will begin to accept international applications under the Patent Cooperation Treaty (PCT) that are filed electronically with a PCT Request prepared in the World Intellectual Property Organization's (WIPO) ePCT system. ePCT allows users to generate a zip file containing a validated PCT Request; the zip file can then be submitted electronically to the RO/US as part of an international application filed using the USPTO's electronic filing system (EFS-Web). Because WIPO's ePCT system is web-based and the servers that support the system are located outside the United States, users of ePCT are reminded that the export of subject matter abroad pursuant to a foreign filing license from the USPTO is limited to purposes related to the filing of foreign applications, which include international applications filed in a Receiving Office other than the RO/US. A foreign filing license does not authorize the export of subject matter into ePCT for generating a PCT Request for filing with the RO/US. Persons who are considering the use of WIPO's ePCT system for preparation of the PCT Request for filing as part of an international application with the RO/US should

consider contacting the Bureau of Industry and Security (BIS) at the Department of Commerce, the Directorate of Defense Trade Controls (DDTC) at the Department of State, or the National Nuclear Security Administration (NNSA) at the Department of Energy for the appropriate clearances where the international application may include technology subject to export controls.

DATES: The change in this notice takes effect on June 1, 2016.

FOR FURTHER INFORMATION CONTACT: Michael Neas, Deputy Director (telephone (571) 272-3289; electronic mail message (michael.neas@uspto.gov)), International Patent Legal Administration, Office of International Patent Cooperation.

SUPPLEMENTARY INFORMATION: The USPTO's electronic filing system (EFS-Web) enables users to electronically file international applications under the PCT with the RO/US. EFS-Web currently permits users to submit the PCT Request by uploading a zip file created using PCT Secure Applications Filed Electronically (PCT-SAFE) software which is made available and maintained by WIPO. The zip file from PCT-SAFE contains a validated PCT Request and fee calculation sheet in PDF format, which are subsequently loaded in the USPTO's Image File Wrapper (IFW). The zip file contains additional files that, among other things, allow the USPTO and WIPO to auto-load application bibliographic data. All other documents and application parts must be prepared and loaded separately in EFS-Web for filing of the international application. Submission of the zip file from PCT-SAFE at the time of filing the international application entitles the applicant to a reduction of the international filing fee. Starting on June 1, 2016, in addition to accepting the zip files generated by PCT-SAFE, the RO/US will also begin to accept international applications filed electronically with

zip files created by WIPO's ePCT system. ePCT is a web-based service that provides for electronic filing of international applications with certain PCT Receiving Offices. ePCT also provides for secure electronic access, file management, and document submissions for international applications held by the International Bureau (IB). The use of ePCT in this manner requires the use of a WIPO user account authenticated with a WIPO digital certificate. ePCT is accessed via an internet browser on the user's system, and all information input into ePCT is stored securely on WIPO's servers. Detailed information on ePCT-Filing can be found at

http://www.wipo.int/export/sites/www/pct/en/epct/pdf/epct_filing_guidelines.pdf.

Both PCT-SAFE and ePCT include validation features to help users properly complete the PCT Request. Since the PCT-SAFE validation can only be made against the version of the software installed on the user's system, the most up-to-date version of PCT-SAFE is required in order to ensure accurate validation. In contrast to PCT-SAFE, validation in the ePCT system is made in real time and does not require software updates.

Furthermore, like PCT-SAFE, the zip file generated by ePCT, which contains a PCT Request in character coded format, also entitles the applicant to the same reduction in international filing fees as indicated in item 4(b) of the PCT Schedule of Fees (http://www.wipo.int/pct/en/texts/rules/rtax.htm#_S). The use of the ePCT zip file would still require all other documents and application parts to be prepared and loaded separately in EFS-Web for filing of the international application.

By using ePCT, an international application will be associated with the user's ePCT account, even before the application is filed, thereby allowing users to share access rights with others prior to filing, if needed. In addition, after the record copy is received by the

IB, the application file may be viewed online via ePCT without the need to separately request access rights.

Applicants who are residents and/or nationals of the United States and its territories can file international applications directly with the Receiving Office of the IB via ePCT or other means, provided that any national security provisions have been met prior to filing, including obtaining any required foreign filing license. See 37 C.F.R. 5.11 and MPEP §140. A foreign filing license does not, however, authorize the use of ePCT to prepare the PCT Request and resultant zip file for filing, as part of an international application, with the RO/US. See 37 CFR 5.15 regarding the scope of a foreign filing license. Also see Scope of Foreign Filing Licenses, 73 FR 42781 (July 23, 2008)(“A foreign filing license from the USPTO does not authorize the exporting of subject matter abroad for the preparation of patent applications to be filed in the United States.”). Using ePCT to create a PCT Request and resulting zip file for later submission to the RO/US does not constitute the “filing of an application in a foreign country or to any foreign patent agency or international patent agency” as provided in 37 CFR 5.15(a). Furthermore, an international application filed in the RO/US is not a “foreign application” within the meaning of 37 CFR 5.15(a) or 5.11(b), which authorize the export of subject matter abroad. See 37 CFR 5.1(b)(2). See also 35 U.S.C. 368(b)(“In accordance with article 27(8) of the treaty, the filing of an international application in a country other than the United States on the invention made in this country shall be considered to constitute the filing of an application in a foreign country within the meaning of chapter 17, whether or not the United States is designated in that international application.”).

As set forth above, a foreign filing license does not authorize the export of technical data into ePCT for generating a PCT Request and resulting zip file for filing as part of an international application with the RO/US. More specifically, to complete the PCT Request and generate the zip file, ePCT requires a title of the invention, which may contain technical data. Moreover, although an abstract is not required for creation of the zip file, ePCT allows users to optionally provide the contents of the application abstract, which may also contain technical data relating to the invention. Since this technical data is stored on servers located outside of the United States, users of ePCT are reminded that the export of this subject matter abroad for the purpose of filing an international application with the RO/US may require the appropriate clearances from the Bureau of Industry and Security (BIS) at the Department of Commerce ([See Scope of Foreign Filing Licenses, supra](#)), the Directorate of Defense Trade Controls (DDTC) at the Department of State, or the National Nuclear Security Administration (NNSA) at the Department of Energy.

An ePCT demo system has been set up to enable filers to familiarize themselves with the system. For further information and to get started, go to the ePCT Portal at: <https://pct.wipo.int/ePCT>. To begin use of ePCT, a user is first required to obtain a WIPO account (<https://pct.wipo.int/wipoaccounts/en/ePCT/public/register.jsf>) and subsequently associate a WIPO digital certificate with the account (<https://pct.wipo.int/wipoaccounts/en/ePCT/private/certificates.jsf> - requires login). Users without a WIPO digital certificate can obtain one from <https://pct.wipo.int/CertRequest/Verisign/services/WorldIntellectualPropertyOrganizationWIPOCustomerCAV2/client/userEnrollMS.htm>.

Date: May 2, 2016

Michelle K. Lee

Under Secretary of Commerce for Intellectual Property and

Director of the United States Patent and Trademark Office

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